

REMARKS

Status of Claims:

Claims 1-3 and 9 are amended. Claim 21 is added as a new claim. Claims 1-21 are presented for examination.

In the Office Action dated January 17, 2006, the Examiner addressed claims 1-19. Claim 20 was previously added as a new claim in the preliminary amendment filed on May 9, 2001. Claim 20 is included in the listing of claims section as previously presented.

35 U.S.C. §102 Rejections:

Claims 1-8 are rejected under 35 U.S.C. §102(a) as being anticipated by Allen (U.S. Patent No. 5,909,638).

The Examiner's rejections are respectfully traversed.

As amended, claim 1 recites:

“A contents rental system, comprising:
a content producer for producing a content;
a rental business server, disposed in a store managed by a rental business operator, for recording the content produced by said content producer and downloading the contents to a record medium corresponding to a command issued by a customer;
and
a reproducing device, disposed on a premise of the customer, for reproducing the contents from the record medium;
wherein the record medium comprises a controlling portion controlling at least one of the recording or the reproducing of the content through at least one of the methods of confirming an encryption code or checking whether a predetermined time has elapsed.”

As amended, claim 1 recites a rental distribution system comprising a content producer, a rental business server for recording contents onto a record medium, and a reproducing device, wherein the record medium comprises a controlling portion controlling

the access of the content through encryption or through a time limit. This controlling portion element of claim 1 is neither disclosed nor suggested by Allen. Allen describes a video content distribution system which utilizes traditional types of mediums, such as VHS tapes, 8mm videotape, or DVD disks. (Allen, col. 5, ll. 47-54.) The use of a record medium comprising a controlling portion as recited in claim 1 is neither expressly nor inherently described by Allen. Allen only recites external control of access to the storage medium, such as a robotic cabinet (Allen, col. 8, ll. 35-57) tracking the number of times a record medium is accessed, or data encryption in the transaction computer system (Allen, col. 11, ll. 34-39).

To anticipate a claim, the reference must teach every element of the claim. Since claim 1 recites features not taught by Allen, claim 1 is believed to be allowable under 35 U.S.C. §102(a). Claims 2-9 are dependent claims of claim 1, and therefore they are believed to be allowable for at least the same reasons given above.

In addition, claims 2 and 3 recite the addition of advertisement pictures to the record medium along with the content. In paragraphs 4 and 5 of the Office Action, the examiner rejected claims 2 and 3 over Allen, citing figure 1 and col. 21 lines 10-25. Figure 1 of Allen does not describe the addition of advertisement pictures to the storage medium. Col. 21 lines 10-25 of Allen describes the display of advertisements by the movie kiosks while the movie kiosks are in idle mode, wherein the movie kiosks are displaced in a retail outlet for dispensing VHS tapes. The display of advertisement by a kiosk screen clearly does not anticipate the addition of advertisement pictures to the storage medium as claimed in claims 2 and 3. To make the distinction clear, claims 2 and 3 are amended to include the limitations that the “advertisement picture is reproduced by the reproducing device disposed on the premise of the customer”. Hence, claim 2 and 3 clearly recite the addition of advertisement picture to the storage medium for reproduction at the customer’s home, and this feature is neither recited nor suggested by Allen. Hence, claims 2 and 3 are allowable for this reason in addition to the reasons stated above for claim 1.

Claims 4-5, 8, and 20 recite the element of a capacitor as part of the record medium. The capacitor performs the function of backing up a memory (claims 4 and 5) or supplying power to a timer (claims 8 and 20). The element of a capacitor is neither described nor

suggested by Allen. As it is commonly known to those skilled in the art, the types medium contemplated by Allen (VHS tape, 8mm tape, DVD disk) do not comprise a capacitor. Because Allen does not teach the element of a capacitor, claims 4-5, 8, and 20 are believed to be allowable for this reason in addition to the reasons stated above for claim 1.

Claims 6-7 recite the element of a timer as part of the record medium. This element is also not taught by Allen. The timer causes the decryption key stored in the storage medium to be erased after a predetermined time has elapsed. The element of a timer in the record medium is not taught by any of the storage mediums suggested by Allen, nor is it commonly known to those skilled in the art. Because Allen does not teach the element of a timer, claims 6-7 are believed to be allowable for this reason in addition to the reasons stated above for claim 1.

35 U.S.C. §103 Rejections

Claims 9-19 are rejected under 35 U.S.C. §103 as being unpatentable over Allen (U.S. Patent No. 5,909,638) in view of Candelore (U.S. Pub. No. 2004/0151314).

The Examiner's rejections are respectfully traversed.

As amended, Claim 9 is recites:

“A content rental system for downloading a content to a record medium of a customer and managing security of the content corresponding to data stored in an IC card of a customer, comprising:

a content producer for producing the content;

a management center for delivering the content produced by said content producer to a plurality of rental business operators;

a rental business server, disposed in a store managed by each of the rental business operators, for recording the content delivered from said management center, downloading the recorded content to the record medium corresponding to a command issued by the customer, wherein the content on the record medium is encrypted based on data stored on the IC card electrically connected to said rental business server; and

a reproducing device, disposed on a premise of the customer, for restoring and decrypting the content from said same record medium, wherein the reproducing device decrypts the content using the data stored on said same IC card electrically connected to said reproducing device.”

As amended, claim 9 recites a rental system in which the rental business server, disposed in a store, downloads encrypted content onto a record medium, where the content is encrypted using data stored on an IC card electrically connected to the rental business server; and, a reproducing device, disposed in a house of a customer, decrypts the content on the record medium using data stored on the same IC card when that same IC card is electrically connected to the reproducing device. These elements are neither described nor suggested by Allen or Candelore, individually or in combination. The applicant appreciates that Candelore teaches the use of a smart card capable of encryption and decryption. (See Candelore, paragraphs 38-39). However, Candelore does not teach or suggest a system in which the IC card is used at a store to download encrypted content onto a record medium, and the same IC card is used at a customer’s premise to decrypt the content.

Furthermore, the system recited in claim 9 is not obvious to one skilled in the art viewing Allen and Candelore together. While Allen teaches encrypting the content at the video capture facility to prevent theft (Allen, col. 9 ll. 59-62), Allen does not provide any motivation to encrypt the content on the storage medium, or to limit the access to the record medium once the record medium is distributed to the customer. MPEP 2143.01 requires that there must be “some teaching, suggestion, or motivation” to combine or modify the prior arts, in order to establish a *prima facie* case of obviousness. Neither Allen nor Candelore provide this motivation.

In light of the reasons stated above, it is thus submitted that the PTO has not made out a *prima facie* case of obviousness under the provisions of 35 U.S.C. 103. Hence, it is submitted that claim 9 and its dependent claims are patentable.

Conclusion:

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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